

REMARKS

Claims 28-37 are pending in the present application. Claims 28 and 37 were amended in this response. No new matter has been introduced as a result of the amendments.

Claim 29 was rejected under 35 U.S.C. §112, first paragraph, for failing to comply with the enablement requirement. Applicants traverse this rejection. Claim 29 corresponds to previously canceled claim 5 that was originally considered on the merits. While the Office Action bases the rejection on a specific passage found on page 14, lines 9-12, Applicants submit that this is but one embodiment discussed in the specification. For example, on page 15, lines, 1-15, other variations are discussed where data packets used to transmit the second signaling information are transmitted in a part of the signaling packets which does not contain any first signaling information. Accordingly, Applicants submit the rejection is improper and should be withdrawn.

Claims 28, 30-32, 36 and 37 were rejected under 35 U.S.C. §103(a) as being unpatentable over *Su et al.* (US Patent 6,693,898) in view of the admitted prior art. Claims 33-35 were rejected under 35 U.S.C. §103(a) as being unpatentable over *Su et al.* (US Patent 6,693,898) in view of the admitted prior art and further in view of *Giordano II et al.* (US Patent 6,285,364). Applicant traverses these rejections. Favorable reconsideration is respectfully requested.

Specifically, the cited art, alone or in combination, does not disclose “an interface unit for operatively coupling the terminal device to the packet-switched communication network wherein the first signaling information is transmitted between the communication network and the data processing device through the interface with the assistance of signaling packets of the packet-switched communication network, and the second signaling information is transmitted between the communication network and the data processing device through the interface with the assistance of data packets of the packet-switched communication network” as recited in claim 28, and similarly in claim 37.

Regarding *Su*, the reference teaches a packet-based intelligent telecommunications network that implements the Bellcore GR-1129 circuit-switched call control model (see Abstract; claim 1). This configuration allows a packet-based intelligent telecommunications network to retain the call control model of the circuit-switched Bellcore GR-1129 standard, while implementing standard packet network protocols. According to *Su*, messaging is

exchanged between the Service Control Point and Service Node/intelligent Peripheral (SN/IP) through the Service Switching Point, as in the GR-1129 model, while messaging between the network Service Switching Point and the Service Control Point may occur according to standards and protocols common to circuit-switched networks, such as SS7 or TCP/IP (col. 2, line 66 – col. 3, line 8). The interface between the Service Switching Point and SN/IP is packet-based, such as H.323, rather than that specified by the GR-1129 standard, where commands provided for by the GR-1129 standard are embedded within the packet-based messaging between the Service Switching Point and SN/IP (col. 3, lines 8-16; col. 4, lines 23-27). Su teaches that the above configuration is necessary to provide backward-compatible transmission that does not necessitate the use of TCAP interfaces that directly connect a packet-based SCP and SN/IP such as those found in networks utilizing the SR-3511 standard (col. 2, lines 19-49; col. 4, lines 53-56).

Furthermore, the terminal 10 described in Su is explicitly disclosed as a packet telephone 10 (col. 4, lines 2-3). Accordingly, there is no teaching in the reference that allows the terminal to process any sort of circuit-switched signaling information as required in claims 28 and 37. Also, as the Office Action properly noted, Su does not disclose the terminal device containing data processing along with the interface unit (Office Action, page 3, last paragraph). However, the Office Action then goes further to cite almost 14 pages of the specification (10 ½ of which are the Applicant's own disclosure of the present invention) to arrive at the conclusion that “[t]here are signaling commands involving terminals in circuit-switching networks that are not supported by H.323,” and base the obviousness rejection on this point. Applicants respectfully submit that this type of examination is improper.

In making a determination that an invention is obvious, the Patent Office has the initial burden of establishing a *prima facie* case of obviousness. *In re Rijckaert*, 9 F.3d 1531, 1532, 28 U.S. P.Q.2d 1955, 1956 (Fed. Cir. 1993). “If the examination at the initial stage does not produce a *prima facie* case of unpatentability, then without more the applicant is entitled to grant of the patent.” *In re Oetiker*, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992).

The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). The initial burden is on the examiner to provide some suggestion of the desirability of doing what the inventor has

done. "To support the conclusion that the claimed invention is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed invention or the examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references." *Ex parte Clapp*, 227 USPQ 972, 973 (Bd. Pat. App. & Inter. 1985). When the motivation to combine the teachings of the references is not immediately apparent, it is the duty of the examiner to explain why the combination of the teachings is proper. *Ex parte Skinner*, 2 USPQ2d 1788 (Bd. Pat. App. & Inter. 1986). (see MPEP 2142).

Further, the Federal Circuit has held that it is "impermissible to use the claimed invention as an instruction manual or 'template' to piece together the teachings of the prior art so that the claimed invention is rendered obvious." *In re Fritch*, 23 U.S.P.Q.2d 1780, 1784 (Fed. Cir. 1992). "One cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention" *In re Fine*, 837 F.2d 1071 (Fed. Cir. 1988).

Moreover, the Federal Circuit has held that "obvious to try" is not the proper standard under 35 U.S.C. §103. *Ex parte Goldgaber*, 41 U.S.P.Q.2d 1172, 1177 (Fed. Cir. 1996). "An-obvious-to-try situation exists when a general disclosure may pique the scientist curiosity, such that further investigation might be done as a result of the disclosure, but the disclosure itself does not contain a sufficient teaching of how to obtain the desired result, or that the claim result would be obtained if certain directions were pursued." *In re Eli Lilly and Co.*, 14 U.S.P.Q.2d 1741, 1743 (Fed. Cir. 1990).

There is nothing in the rationale contained in the Office Action that remotely teaches or suggests the proposed combination. Furthermore, nothing of substance was identified in the aforementioned passages that could even serve as a basis for combining the subject matter in the manner suggested. What relevance is there in the fact that non-H.323 signaling commands exist to the recited features as a whole? Applicants submit that the rejection under 35 U.S.C. §103 is improper and should be withdrawn.

In light of the above arguments, Applicant submits that the present claims are allowable over the prior art. Applicant also requests that a timely Notice of Allowance be issued in this case. Should there be any additional charges regarding this application, the Examiner is hereby authorized to charge Deposit Account 02-1818 for any insufficiency of payment.

Respectfully submitted,

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